

REMARKS

Claims 1-85 were examined in the Office Action under reply and stand rejected under (1) the judicially created doctrine of obviousness-type double patenting over U.S. Patent No. 6,274,323; (2) 35 U.S.C. §102(e) (claims 1-5, 12-15, 21-28, 38-45, 52, 53, 55-62, 68, 70, 72, 74-76 and 80-84); and (4) 35 U.S.C. §103(a) (claims 6-11, 16-20, 29-37, 46-51, 54, 63-67, 69, 71, 73, 77-79 and 85). These rejections are believed to be overcome for reasons discussed below.

Applicants note with appreciation the withdrawal of the previous rejections under 35 U.S.C. §112, second paragraph.

Overview of the Above Amendments:

Claims 2, 11, 12 and 43-85 have been canceled and claims 1, 3, 5, 13 and 26 amended. In particular, claim 1 has been amended to incorporate the recitations from claims 11 and 2 and claims 3, 5, 13 and 26 have been amended to depend from claim 1 rather than cancelled claim 2. Amendment of claims 1, 3, 5, 13 and 26 and cancellation of claims 2, 11, 12 and 43-85 is made without prejudice, without intent to abandon any originally claimed subject matter, and without intent to acquiesce in any rejection of record. Applicants reserve the right to bring the canceled claims again in a related application.

The Double Patenting Rejection:

Claims 1-85 were rejected under the judicially created doctrine of obviousness-type double patenting over claims 1-40 of U.S. Patent No. 6,274,323 to Bruchez in view of U.S. Patent No. 6,083,763 to Balch. Applicants are submitting a Terminal Disclaimer in compliance with 37 CFR §1.321(c). Thus, this basis for rejection has been overcome and withdrawal thereof is respectfully requested.

Rejections Under 35 U.S.C. §102(e):

Claims 1-5, 12-15, 21-28, 38-42, 43-45, 52, 53, 55-62, 68, 70, 72, 74-76 and 80-84 were rejected under 35 U.S.C. §102(e) as anticipated by U.S. Patent No. 6,083,763 to Balch ("Balch"). Applicants submit, for reasons of record, that Balch fails to anticipate the claimed invention.

Nevertheless, solely in an effort to advance prosecution, applicants have added the recitations from claim 11 which was not subject to the rejection into claim 1. All remaining claims either directly or ultimately depend from claim 1. Thus, this basis for rejection has been overcome and withdrawal thereof is respectfully requested.

Rejections Under 35 U.S.C. §103(a):

Claims 6-11, 16-20, 29-37, 46-51, 54, 63-65, 69, 71, 73, 77 and 85 were rejected under 35 U.S.C. §103(a) as unpatentable over Balch in view of U.S. Patent No. 6,274,323 to Bruchez ("Bruchez"). Claims 46-51, 54, 63-65, 69, 71, 73, 77 and 85 have been cancelled rendering the rejection moot vis-a-vis these claims. With respect to the remaining claims, applicants note that claim 1 was not subject to this rejection. All pending claims either directly or ultimately depend from claim 1. Thus, this basis for rejection has been overcome.

Moreover, as previously explained, Bruchez is not properly citable art against the present claims. In particular, Bruchez falls under the provisions of 35 U.S.C. §103(c) as Bruchez's filing date is less than one year prior to the effective filing date of the present application and the subject matter of Bruchez as well as the invention claimed herein were, at the time the invention was made, owned by Quantum Dot Corporation or subject to an obligation to assign to Quantum Dot Corporation. See, MPEP §706.02(I)(1). To evidence common ownership, applicants are submitting the Declaration of Kenneth Barovsky, Vice President and Intellectual Property Counsel of the assignee of this application and of the Bruchez patent. The Declaration includes the statement considered sufficient evidence to establish common ownership of, or an obligation for assignment to, the same organization. See, MPEP §7.06(I)(2)(II).

The Examiner asserts that applicants' previous argument regarding Bruchez was unpersuasive as "Bruchez prior art would be based on 102 a date which would still provide the basis for 103 a rejection." Office Action, page 9. However, the Examiner is in error. As detailed in MPEP 706.02(a)(III), in order to apply a §102(a) rejection to a §102(e) reference "the reference must have a publication date earlier in time than the effective filing date..." In the present case, the International publication date of the PCT application corresponding to Bruchez was November 16, 2000, several months **after** applicants' priority date of May 28, 2000. See,

the accompanying front page of PCT Publication No. WO00/68692. Thus, contrary to the Examiner's statement, Bruchez is not properly a §102(a) reference against the present claims. Accordingly, Bruchez cannot be used to preclude patentability under 35 U.S.C. §103(a). Withdrawal of this basis for rejection is therefore respectfully requested.

Claims 6-10, 16-20, 30-37, 46, 48-51, 69, 71, 73, 77 and 85 were rejected under 35 U.S.C. §103(a) as unpatentable over Balch in view of U.S. Patent No. 6,207,392 to Weiss ("Weiss"). Claims 46, 48-51, 69, 71, 73, 77 and 85 have been cancelled. As with the rejection above, applicants note that claim 1 was not subject to this basis for rejection. All pending claims either directly or ultimately depend from claim 1. Moreover, claim 11 was not subject to this rejection. Claim 1 now incorporates the recitations of claim 11 and, as explained above, all pending claims depend from claim 1. Thus, this basis for rejection has also been overcome. Withdrawal thereof is respectfully requested.

Claims 29, 47, 54, 63-65, 78 and 79 were rejected under 35 U.S.C. §103(a) as unpatentable over Balch in view of U.S. Patent No. 6,426,197 to Duckworth et al. ("Duckworth"). Claims 47, 54, 63-65, 78 and 79 have been cancelled. Claims 1 and 11 were not subject to this rejection. Claim 1 has been amended to incorporate the recitations from claim 11. Thus, claim 1 and all the remaining claims are free of this rejection. Withdrawal of this basis for rejection is therefore respectfully requested.

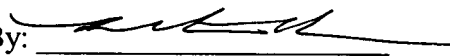
Finally, claims 66 and 67 were rejected under 35 U.S.C. §103(a) as unpatentable over Balch in view of Duckworth and further in view of U.S. Patent No. 5, 942,394 to Ellis et al. ("Ellis"). Claims 66 and 67 have been cancelled. Thus, this rejection no longer applies and withdrawal thereof is respectfully requested.

CONCLUSION

Applicants respectfully submit that the claims define a patentable invention. Accordingly, a Notice of Allowance is believed in order and is respectfully requested. If the Examiner notes any further matters which he believes may be resolved by a telephone interview, he is encouraged to contact the undersigned by telephone at 650-493-3400.

Respectfully submitted,

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